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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/812,406	03/26/2004	Nobuyuki Takase	3599-000004/CO	1285

27572 7590 10/18/2007

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EXAMINER	
MORILLO, JANELL COMBS	

ART UNIT	PAPER NUMBER
1793	

MAIL DATE	DELIVERY MODE
10/18/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/812,406	TAKASE ET AL.	
	Examiner	Art Unit	
	Janelle Combs-Morillo	1792	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *02 August 2007*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1 and 2* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1 and 2* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

2. Claims 1-2 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP 09-176769A (JP'769).

JP'769 teaches an aluminum alloy for extrusion molding comprising (in wt%): 3.0-6.0% Si, 0.1-1.0% Mn, 0.4-1.0% Mg, optionally one or more from: 0.15-2.0% Cu, 0.05-0.30% Cr, 0.1-1.0% Fe, 0.01-0.10% Ti, and typically 0.00-0.01% Zn (see examples Table 2-1), which overlaps the instant ranges of Si, Cr, Fe, Mn, Cu, and Zn, and touches the boundary/is a close approximation of the presently claimed maximum of Mg.

Further concerning the minimum range of Mg taught by JP'769 of 0.4% does not fall within the presently claimed maximum of 0.39% Mg, a prima facie case of obviousness exists where the claimed ranges and prior art ranges do not overlap but are close enough that one skilled in the art would have expected them to have the same properties. *Titanium Metals Corp. of America v. Banner*, 778 F.2d 775, 227 USPQ 773 (Fed. Cir. 1985). Because 0.4% Mg is held to be close enough that one skilled in the art would have expected them to have the same properties as 0.39% Mg, it is held that JP'769 has created a prima facie case of obviousness of the presently claimed invention. Overlapping ranges have been held to be a prima facie case of obviousness, see MPEP § 2144.05.

Concerning the instant claim language of "excelling in caulking properties", because the prior art teaches an overlapping alloy composition, processed in a substantially similar manner, then substantially the same properties, such as caulking properties, are also expected to result (see also above discussion).

When the Examiner has established a *prima facie* obviousness, the burden then shifts to the applicant to rebut. *In re Dillon*, 919 F.2d 688, 692, 16 USPQ2d 1897, 1901 (Fed. Cir. 1990) (en banc). Rebuttal may take the form of "a comparison of test data showing that the claimed compositions possess unexpectedly improved properties... that the prior art does not have, that the prior art is so deficient that there is no motivation to make what might otherwise appear to be obvious changes, or any other argument.. that is pertinent." Id. at 692-93; USPQ2d 1901. Applicant has not clearly shown specific unexpected results with respect to the prior art of record or criticality of the instant claimed range (wherein said results must be fully commensurate in scope with the instantly claimed ranges, etc. see MPEP 716.02 d).

Double Patenting

3. The terminal disclaimer filed on August 2, 2007 has been found proper and is hereby recorded.

Response to Amendment/Arguments

4. In the response filed on August 2, 2007, applicant submitted various arguments traversing the rejections of record, and a 1.132 declaration.

5. The declaration under 37 CFR 1.132 filed August 2, 2007 is insufficient to overcome the rejection of claims 1 and 2 based upon JP'769 as set forth in the last Office action because:

though the examiner agrees Ex. I of JP'769 is substantially identical *in composition* to comparative example 16 in the 1.132 declaration filed 1/30/2007 as well as the 1.132 declaration filed 8/2/2007, wherein Comp. Ex. 16 consists of: 4.04% Si, 0.30% Fe, 0.15% Cu, 0.03% Ti, 0.19% Mn, 0.40% Mg, 0.15% Cr, 0.01% Zn, balance aluminum, and exhibits a critical upsetting ratio of 40.1%, which applicant argues is inferior to the instant invention of a wear resistant Al-Si-Cu-Fe-Cr alloy substantially as presently claimed, complete with the claimed Mn and Mg ranges that are critical to obtaining an upsetting ratio $\geq$ 43%. However, though the examiner agrees that applicant has shown unexpected results with respect to Comp. Ex. 16 in the declarations filed 1/30/2007 and 8/2/2007, as stated in the previous response (see item 8 of office action mailed 5/3/2007), applicant does not detail the processing history of said example (it is not clear said Ex. is clearly representative of the closest prior art of JP'769, nor has applicant argued said example is closer to the instant invention than Ex. I of JP'769), and has not clearly overcome the rejection in view of JP'769. The examiner suggests applicant file a supplemental declaration under 37 CFR 1.132, detailing the processing history / explaining why Comp. Ex. 16 is clearly representative of the closest prior art of JP'769. In the declaration filed 8/2/2007, declarant states Ex. I of JP'769 is the closest prior art composition, but did not clarify how Comp. Ex. 16 is clearly representative of said example beyond composition- i.e. complete with processing history. Where the comparison is not identical with the reference disclosure, deviations therefrom should be explained, see citation below.

6. An affidavit or declaration under 37 CFR 1.132 must compare the claimed subject matter with the closest prior art to be effective to rebut a prima facie case of obviousness. In re Burckel, 592 F.2d 1175, 201 USPQ 67 (CCPA 1979), see also MPEP 716.02(e). "A comparison of the

claimed invention with the disclosure of each cited reference to determine the number of claim limitations in common with each reference, bearing in mind the relative importance of particular limitations, will usually yield the closest single prior art reference." In re Merchant, 575 F.2d 865, 868, 197 USPQ 785, 787 (CCPA 1978) (emphasis in original). Where the comparison is not identical with the reference disclosure, deviations therefrom should be explained, In re Finley, 174 F.2d 130, 81 USPQ 383 (CCPA 1949), and if not explained should be noted and evaluated, and if significant, explanation should be required. In re Armstrong, 280 F.2d 132, 126 USPQ 281 (CCPA 1960).

Conclusion

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Janelle Combs-Morillo whose telephone number is (571) 272-1240. The examiner can normally be reached on 8:30 am- 6:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Roy King can be reached on (571) 272-1244. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JCM
October 12, 2007